

### **REMARKS**

No claims are amended, as a result, claims 5-11 and 16-31 are now pending in this application. Of these, claims 5, 6, 8-11, 17 and 22-31 stand rejected as allegedly unpatentable over several reference combinations involving Carino.

A detailed response to the rejection follows. However, applicant reserves all applicable rights not exercised in connection with this response, including, for example, the right to swear behind one or more of the cited references, the right to rebut any tacit or explicit characterization of the references, and the right to rebut any asserted motivation for combination. Applicant makes no admission regarding the prior art status of the cited references, regarding them only as being of record in the application.

#### **Response to §103 Rejections Based on Carino**

Claims 5, 6, 8-11, 17 and 22-31 were rejected under 35 USC §103(a) as allegedly unpatentable over O'Phelan (U.S. Patent No. 6,275,729) in view of Carino (U.S. Patent No. 4,047,790). Similarly, claims 5, 6, 8, 17, 22, and 24-31 were rejected as allegedly unpatentable over Kent (U.S. Patent No. 4,546,415) in view of Carino and over Dain (U.S. Patent No. 4,802,064) in view of Carino. Claims 9-11 were rejected over Kent and Carino in view of Rubin (U.S. Patent No. 6,040,974) and over Dain and Carino in view of Rubin.

In response to all the rejections, applicant submits respectfully that the Action fails to set forth a proper prima facie case of obviousness for lack of a valid teaching or suggestion to combine. Specifically, the Action proposes that one of ordinary skill would have combined the recess of Carino with the header of O'Phelan, Kent, or Dain "in order to avoid the manufacturing step and expense of sealing the fasteners with epoxy and to prolong the life of the capacitor by providing a high integrity seal so the electrolytic fluid retained in the capacitor [citing Carino, specifically its] abstract; figure 5; col. 1 @ 31-50; col. 2 @ 51-48; col. 4 @ 22 – col. 6 @ 8)."

However, even if one were to accept that Carino teaches its recesses as obviating a need to epoxy, there's no evidence cited that one of skill would regard O'Phelan, Kent, or Dain as teaching an epoxy step that was subject to elimination. Indeed, a computer search of O'Phelan, Kent, and Dain reveals that each is entirely devoid of the term "epoxy." Moreover, no evidence

is offered to indicate that one of skill would recognize Carino's sealing structures and methods as prolonging the life of O'Phelan's, Kent's, or Dain's capacitor relative to that already offered.

The law requires that a prima facie case of obvious must include object prior art teachings that one of skill would have found it desirable to make the proposed combination or modification. Here, the Action fails to substantiate that one of ordinary skill would have recognized it desirable to use Carino's sealing structures and techniques in place of those in the principle references.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the rejections based on the unsubstantiated combination of O'Phelan, Kent, and Dain with Carino.

### Conclusion

In view of these remarks, applicant requests respectfully that the Examiner reconsider and withdraw the rejections. Further, applicant requests, pursuant to MPEP § 809 that the Second Restriction Requirement be withdrawn if and when claims 30 and 31 are deemed allowable. Applicant respectfully invites the Examiner to telephone its patent counsel Eduardo Drake at (612) 349-9593 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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26 May 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, MS: Amendments, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26 day of May, 2004.

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Signature